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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,413	12/14/2000	Santokh S. Badesha	D/A0592Q	8801

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

8

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/737,413

Applicant(s)

BADESHA ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE f this c mmunication appears n th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Request for Reconsideration

1. This action is in response to the request for reconsideration mailed May 29, 2003. Claims 1-21 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Swift et al (U.S. 6,381,436).
4. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) where the silicone elastomer is a polyorganosiloxane wherein the polyorganosiloxane has the same formula displayed in claim 7, where R is hydrogen or substituted or unsubstituted alkyl, alkenyl or aryl having

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less than 19 carbon atoms, each of A and B may be any of methyl, hydroxy or vinyl groups and $0 < m/n < 1$ and $m+n > 350$ (column 4, lines 10-24). Additionally, the reference has the same formula limitation presented in claim 2, where W is usually potassium; X, Y are aluminum, magnesium, iron or lithium and Z is silicon or aluminum (column 5, lines 40-46). Badesha discloses the formula in claim 9 where n" is 350 to 2700 (column 7, lines 1-10). Badesha discloses 10% weight of the mica-type silicate (column 5, lines 9-10) where the mica-type silicate comprises hectorite (column 14, lines 9-10). An image *for forming images on a recording medium* is directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A development component *to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface* is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of

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a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Although Badesha teaches transferring, the reference does not explicitly teach a transfix member.

Swift teaches an image forming apparatus comprising a charging station, developer, transfer station and intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47) having an adhesive disposed therein (column 4, lines 49-57).

Badesha and Swift are analogous art because they are both from the field of image forming machines. It would have been obvious to one of ordinary skill in the art to include the transfix component of Swift in the image forming apparatus of Badesha because Swift teaches interchanging the fuser and a transfix component in order to receive toner to be fixed to a substrate (column 4, lines 39-49).

Claim Rejections – 35 USC § 103(a)

5. Claims 1-17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Badesha et al. (U.S. 6,482,504).
6. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a

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transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) where the silicone elastomer is a polyorganosiloxane wherein the polyorganosiloxane has the same formula displayed in claim 7, where R is hydrogen or substituted or unsubstituted alkyl, alkenyl or aryl having less than 19 carbon atoms, each of A and B may be any of methyl, hydroxy or vinyl groups and $0 < m/n < 1$ and $m+n > 350$ (column 4, lines 10-24). Additionally, the reference has the same formula limitation presented in claim 2, where W is usually potassium; X, Y are aluminum, magnesium, iron or lithium and Z is silicon or aluminum (column 5, lines 40-46). Badesha discloses the formula in claim 9 where n" is 350 to 2700 (column 7, lines 1-10). Badesha discloses 10% weight of the mica-type silicate (column 5, lines 9-10) where the mica-type silicate comprises hectorite (column 14, lines 9-10). An image *for forming images on a recording medium* is directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A development component *to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface* is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Although Badesha teaches transferring, the reference does not explicitly teach a transfix member comprising a transfix substrate comprising a fabric.

Badesha '504 teaches an image forming apparatus comprising a charge-retentive surface, a development component and a transfix member (column 3, lines 44-59). Badesha '504 further teaches a transfix member, wherein said substrate comprises a material selected from the group consisting of fabrics and metals, where the fabric material is selected from the group consisting of graphite fabric, fiberglass, cellulose and polyethylene (column 10, lines 39-48) where the transfix member comprises silicone

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material and a heating component associated with said substrate (column 10, lines 52-65). Badesha '643 and Badesha '504 are analogous because they are both from the field of image forming apparatus. It would have been obvious to one of ordinary skill in the art to include a transfix substrate comprising a fabric comprising a material selected from the group consisting of fabrics and metals, where the fabric material is selected from the group consisting of graphite fabric, fiberglass, cellulose and polyxylene in the image forming apparatus of Badesha '643 because Badesha '504 teaches the transfix component transfers and fuses the developed image (column 3, lines 50-51) where the fabric material improves mechanical strength and electrical insulating properties (column 8, lines 31-32).

Response to Arguments

7. The indication that claims 11-12, 18-19 and 21 as being objectionable was an oversight and as such, claims 1-12, 18-19 and 21 remain rejected for reasons of record. Remarks of rejection made under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Swift et al (U.S. 6,381,436) has been considered but is unpersuasive. Applicant argues Badesha does not teach or suggest the presently claimed transfix component of the image forming apparatus. Examiner is not persuaded by this argument. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Swift teaches an image forming apparatus comprising a charging station, developer, transfer station and intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47). Applicant argues there is no teaching in Badesha that the outer layer taught for use with the fuser member for fixing a toner image to a toner substrate, could be used in a transfix member. Examiner is not persuaded by this argument because Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45) and Swift teaches an image forming apparatus comprising a charging station, developer, transfer station and intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47). Applicant further argues there would have been no expectation for success that a layer taught for use with a fuser member would work as a layer for a transfix member as claimed. This is not true because Swift teaches an image forming apparatus comprising an intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47). Although Badesha does not explicitly teach a transfix member, Swift teaches the conventionality of using a transfix component instead of a fuser component, which Badesha comprises. Applicants submit that one of ordinary skill in the art would not have been motivated to use an outer layer taught for use on a fuser member, for use as an outer layer in a transfix component as claimed. Applicant lacks support for this ascertainment and furthermore, Swift teaches the

interchangeability of the transfix and fuser members. Applicant argues the Office Action states elements of the claimed apparatus are directed to intended use and product by process and the claims are directed to an apparatus and not a product by process. Examiner acknowledges Applicant's argument and although the overall claims are directed to an image forming apparatus, various aspects of the apparatus are directed to intended use and product by process claim limitations, absent any evidence to the contrary. An image *for forming images on a recording medium* is directed to intended use and a transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. Additionally, a development component *to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface* is a product by process claim limitation, which is given little patentable weight. Applicant reiterates Badesha does not teach the claimed parts of the claimed apparatus including all three of a transfer component, intermediate transfer component, and transfix component. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer

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component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45) and Swift teaches an image forming apparatus comprising a charging station, developer, transfer station and intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47). Applicant argues Swift does not teach or suggest an outer layer comprising a mica type layered silicate and silicone elastomer. The primary purpose of the Swift reference is to teach the conventionality of an image forming apparatus comprising a transfix component that can be utilized in place of the fuser member of Badesha. Applicant argues that Swift's teaching that a developed toner image can be transferred to either a fuser member or transfix member is not a teaching that an outer layer taught as useful as an outer layer of a fuser member would work as an outer layer of a transfix member as claimed. Examiner respectfully disagrees because Swift's teaching can be applied to an image forming apparatus that can interchange a fuser and transfix member. It would have been obvious to one of ordinary skill in the art that if the parts can be interchanged, their functionality and utility is additionally equivalent.

Remarks of rejection made under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Badesha et al. (U.S. 6,482,504)) has been considered but is unpersuasive. Applicant argues there is no teaching that would have motivated one of skill in the art to substitute the outer mica-type silicate layer taught by Badesha '643 as useful as an outer layer for a fuser member or transfix member as claimed by Badesha '504. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a

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development component, a transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) and Badesha '504 teaches an image forming apparatus comprising a charge-retentive surface, a development component and a transfix member (column 3, lines 44-59). In response to applicant's argument that there is no mention of the claimed mica-type silicate outer layer in the secondary reference, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Badesha '643 discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5).

Remarks of obviousness-type double patenting of Badesha et al. (U.S. 6,411,793) in view of Badesha et al (U.S. 5,846,643) has been considered and is withdrawn due to arguments set forth by Applicant of Badesha '643 and Badesha '793 lacking teaching of the fuser member working well as a transfix member.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

